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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,515	07/09/2001	Roger Collins	05545P002	7416
7590 Thomas C. Webster BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP Seventh Floor 12400 Wilshire Boulevard Los Angeles, CA 90025-1026				
EXAMINER				
CHEN, WENPENG				
ART UNIT		PAPER NUMBER		
2624				
MAIL DATE		DELIVERY MODE		
07/30/2009		PAPER		

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* ROGER COLLINS

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Appeal 2009-003808  
Application 09/902,515  
Technology Center 2600

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Decided:<sup>1</sup> July 30, 2009

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Before MAHSHID D. SAADAT, MARC S. HOFF,  
and THOMAS S. HAHN, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the Decided Date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Appellant appeals under 35 U.S.C. § 134(a) from a Final Rejection of claims 30-51. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

#### STATEMENT OF THE CASE

Appellant's invention relates to a method for compressing a message based on applying first and second code words to encode data in first and second fields. (Spec. 5.)

Claim 30 is illustrative of the claimed invention and reads as follows:

30. A method comprising:

receiving data at an interface from a service;

identifying at the interface whether the data is an electronic mail (email) message corresponding to a user mailbox or address book data corresponding to the user address book;

applying a first set of code words to encode data in the email message; and

applying a second set of code words to encode the address book data.

The prior art applied in rejecting the claims on appeal is:

Carr	US 5,293, 379	Mar. 8, 1994
Unger	US 5,991,713	Nov. 23, 1999
Togawa	US 2002/0004821 A1	Jan. 10, 2002 (filed Mar. 28, 2001)
Lindquist	US 6,687,362 B1	Feb. 3 2004 (filed Feb. 11, 2000)
Shaffer	US 6,842,768 B1	Jan. 11 2005 (filed Mar. 1, 2000)

Claims 30, 43, and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Carr and Togawa.

Claims 36-37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Carr and Togawa, in view of Unger.

Claims 30-32, 38-40, and 43-51 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer in view of Carr and Togawa.

Claim 42 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer, Carr, and Togawa, in view of Unger.

Claims 30, 33-35, 38, and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shaffer, Lindquist, Carr, and Togawa.<sup>2</sup>

We refer to the Appeal Brief (filed Apr. 24, 2008) and the Answer (mailed Jul. 10, 2008) for their respective details. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant did not make in the Brief have not been considered and are deemed waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

## ISSUE

Appellant's arguments are limited to the rejection of claims 30, 43, and 46 over Carr and Togawa (Br. 6) and assert patentability of the remaining claims based on these arguments (Br. 11). Therefore we select claim 30 as representative of the claims on appeal. *See* 37 C.F.R. § 41.37(c)(1)(vii).

In rejecting claim 30, the Examiner relies on Carr for disclosing the steps of identifying whether the data is an e-mail message or address book data, applying a first set of code words to the data in the e-mail message, and

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<sup>2</sup> All the claim rejections are discussed in pages 2-13 of the Final Rejection.

applying first and second sets of code words to the identified data of claim 30. The Examiner asserts that Carr does not disclose identifying whether the data corresponds to a user mailbox or address book, for which the Examiner relies on Togawa (Ans. 3-5). Appellant does not dispute the teachings of Togawa and merely challenges the teachings of Carr with respect to the claimed steps of identifying different types of data (Br. 8-11). Appellant specifically repeats the portions of Carr relied on by the Examiner and argues that Carr does not teach or suggest “a process of *identifying whether data is an email message or address book data*” (Br. 11). Thus, the arguments made by Appellant present us with the following issue:

Has Appellant shown that the Examiner erred in rejecting claims 30-51 under 35 U.S.C. § 103(a) by combining Carr and Togawa to specifically teach the claimed step of identifying whether the data is an email message or address book data?

#### FINDINGS OF FACT

The following findings of fact (FF) are relevant to the issue involved in the appeal.

1. Appellant does not dispute the teachings of Togawa, as relied on by the Examiner, related to email messages corresponding to a user mailbox and address book data corresponding to the user address book. (Br. 9.)
2. Carr relates to a data processing system which uses a compression method by reformatting data packets in static and dynamic fields as well as the user-data information. (Abstract; col. 3, ll. 31-51.)

3. As shown in Figure 4, Carr discloses address information in the static field and user data in the packet data field. (Col. 5, l. 27 – col. 7, l. 39.)

4. Carr further shows in Figure 5 that the fields are reordered in order to separate static, semi-static, and dynamic fields as well as user data fields. (Col. 7, ll. 16-27.)

5. Carr discloses the process of reformatting and data compression, as shown in Figure 7, by first determining whether a packet has been received. (Col. 7, ll. 46-51.)

6. Upon receiving a packet, Carr identifies the packet type by examining the packet's type field and reformats the packet by calling a subroutine which has been designed precisely for the identified type. (Col. 7, ll. 52-57.)

#### PRINCIPLES OF LAW

“[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). “On appeal to the Board, an applicant can overcome a rejection by showing insufficient evidence of *prima facie* obviousness . . .” *In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *See In re Kahn*, 441 F.3d at 987-88; *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

*KSR Int’l. Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007).

Such a showing requires

‘some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

*Id.* at 418 (quoting *In re Kahn*, 441 F.3d at 988).

## ANALYSIS

We agree with the Examiner’s line of reasoning and find that Carr does teach the claimed step of identifying whether the data is an email message or address book data, as set forth in claim 30. As pointed out by the Examiner (Ans. 6-9), Carr discloses a compression method based on the types of the data field (FF 2-3). The Examiner appropriately relies on the disclosure of Carr describing the process for reordering the static, dynamic, and user-data fields (FF 4). Therefore, contrary to Appellant’s arguments (Br. 11) that Carr does not disclose or suggest the identifying step, the relied on portions of Carr distinguish between different fields, such as static, dynamic, or user-data fields.

Additionally, we also agree with the Examiner’s finding (Ans. 7-8) that Carr further discloses the algorithm used for reformatting and data compression. Carr specifically identifies the packet type and applies a

corresponding subroutine for reformatting the identified packets in those fields (FF 5-6).

Therefore, we disagree with Appellant's arguments that the claimed step of identifying whether the data is an email message or address book data is absent in Carr's disclosure. We also note that Appellant's arguments in the Appeal Brief with respect to Togawa (Br. 9) do not challenge the Examiner's reliance on Togawa for teaching email messages corresponding to a user mailbox and address book data corresponding to the user address book related to updating and processing e-mail addresses (FF 1). As such, we find that Appellant has not overcome the prima facie case of obviousness set forth by the Examiner and supported by "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness," as required by the holding in *In re Kahn*.

### CONCLUSION

In view of our analysis above and using KSR standards, we find that the evidence provided by the Examiner, when considered as a whole, supports the Examiner's prima facie obviousness rejection by teaching the claimed step of identifying whether the data is an email message or address book data. Therefore, Appellant has not shown error in the Examiner's position with respect to the combination of the applied references. Accordingly, we sustain the 35 U.S.C. § 103(a) rejection of all the claims over Carr and Togawa, or over Carr and Togawa in various combinations with Unger, Shaffer, and Lindquist.



ORDER

The decision of the Examiner rejecting claims 30-51 affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. 1.136(a)(1)(iv).

AFFIRMED

gvw

Thomas C. Webster  
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP  
12400 Wilshire Boulevard, Seventh Floor  
Los Angeles, CA 90025-1026